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Mailed :

In re Application of

Jeremy Thaler et al.

Serial No. 10/705,657

Filed: November 10, 2003

For: Peanut Butter With An Organic Stabilizer And Method For
Manufacture Thereof

DECISION ON
PETITION

This is a decision on Applicants' second request that the Commissioner intervene in this application and directs the Examiner to provide a timely and comprehensive examination filed on April 6, 2009.

A final rejection was mailed on January 23, 2008. A pre-appeal conference decision to reopen prosecution was mailed on July 30, 2008. The Examiner issued a non-final rejection on August 22, 2008. Applicants filed an Appeal Brief on 10/20/08. The Examiner's Answer was mailed out on February 6, 2009 and Applicants filed a reply brief on April 6, 2009.

Applicants assert that the Examiner issued an Examiner's Answer which set forth new grounds for rejection by Examiner's Answer and a Supplemental submission dated March 25, 2009 and has done so without preparing a revived Examiner's answer that incorporates "reworked" rejections and providing Applicant's an opportunity to either elect to re-open prosecution or to proceed on appeal. Applicants assert that the Examiner's Answer and Supplemental communication are inconsistent with the non-final rejections of August 2008 that were appealed.

The Office Action from August 22, 2008 rejected claims 1, 10, 12-18, 20, and 22-23 under 35 U.S.C. 103(a) over Liu, Hinds, Harris and Bailey's Industrial Oil and Fat Products. Further claims 1, 3-8, 10, 12-18, 20, and 22-23 were also rejected under 103 (a) in view of Hinds and Baileys Industrial Oil and Fat Products. Claim 24 was rejected under 103(a) over Hinds and Liu. Claims 9, 11, 19 and 24 were rejected under over Hinds, Harris and Krisinski. Claims 9, 11, 19 and 24 were also rejected under 103(a) over Hinds, Harris and Krisinski.

The Examiner's Answer from February 6, 2009 rejected claims 1, 10, 12-18, 20, and 22-23 under 35 U.S.C. 103(a) over Liu, Hinds and Harris. Further claims 1, 3-8, 10, 12-18, 20, and 22-23 were also rejected under 103 (a) in view of Hinds. Claims 9, 11, 19 and 24 were rejected

over Liu in view of Hinds, Harris and Krisinski. Claims 9, 11, 19 and 24 were also rejected under 103(a) over Hinds and Krisinski.

The Examiner sent out a supplemental Communication on March 25, 2009 to address inconsistencies of the Examiner's Answer with the non-final rejection of August 22, 2008.

Upon review, the Examiner's Answer dropped the use of the reference "Baileys Industrial Oil and Fat Product" under the rejection of claims 1, 3-8, 10, 12-18, 20 and 22-23. The rejection to claim 24 over Hinds and Liu was dropped. The rejection of claims 9, 11, 19 and 24 under Hinds, Harris and Krisinski was changed to also include the reference Liu. The Examiner asserts that the addition of the Liu reference was to be consistent with rejection from the non-final office action of August 22, 2008. The rejection to claims 9, 11, 19 and 24 that were rejected under 103(a) to Hinds, Harris and Krisinski was changed to only be over Hinds and Krisinski.

In the non-final office action preceding the Examiner's Answer, Liu was used to reject claims 1, 10, 12-18, 20, and 22-24. The Examiner's Answer uses Liu to reject claims 1, 9-20 and 22-24. Claims 9, 11 and 19 were not previously rejected under Liu in the non-final office action. There is no new ground of rejection when the basic thrust of the rejection remains the same such that an appellant has been given a fair opportunity to react to the rejection. See *In re Kronig*, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976). Where the statutory basis for the rejection remains the same and the evidence relied upon in support of the rejection remains the same, a change in the discussion of, or rationale in support of, the rejection does not necessarily constitute a new ground of rejection. *Id.* at 1303, 190 USPQ at 427 (reliance upon fewer references in affirming a rejection under 35 USC 103 does not constitute a new ground of rejection). Claims 9, 11 and 19 were not previously rejected under Liu in the non-final office action.

In the previous petition decision, the examiner was required to send a corrected Examiner's Answer that identifies the rejection as a new ground of rejection and includes the approval of the TC Director or designee. The Examiner sent out a Supplemental Examiner's Answer on July 23, 2009 that did not indicate that the Technology Center Director or designee approved the Supplemental Examiner's Answer and also failed to identify any time period or alternative for response as required by the previous petition decision

DECISION

The petition is **GRANTED**.

The Examiner is directed to clarify the record and to assure that the procedures set forth in MPEP 1207 and the prior Decision on Petition has been followed. The Examiner is required to send a corrected Examiner's Answer that identifies the rejection as a new ground of rejection and includes the approval of the TC Director or designee. The appellant may then file either a request that prosecution be reopened by filing a reply under 37 CFR 1.111, or a request that the appeal be maintained by filing a reply brief or resubmitting the previously-filed reply brief, within two months from the mailing of the corrected answer

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